

Confirmation No. 5258

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	GIANNINI <i>et al.</i>	Examiner:	Karmis, Stefanos
Serial No.:	09/531,102	Group Art Unit:	3693
Appeal No.:	2009-009186		
Filed:	March 17, 2000	Docket No.:	JARB.004PA
Title:	Merged Images Viewed Via a Color-Code Scheme		

REQUEST FOR RECONSIDERATION OF APPEAL DECISION

Commissioner For Patents
P.O. Box 1450
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Customer No. 40591

Dear Sir:

This Request for Reconsideration is submitted pursuant to 37 CFR § 41.52 and in response to the Appeal Decision dated January 25, 2011. Please reconsider the Appeal Decision in view of the following arguments and remarks.

Authorization is provided to charge **Deposit Account No. 50-0996 (JARB.004PA)** any SMALL-ENTITY fees related to this filing.

Arguments

The Board Of Patent Appeals And Interferences (“BPAI”) Should Expressly Recognize That The § 112(2) Rejection Of Claims 25-26 (Indefiniteness) Is Based On An Interpretation That Has No Context And That Is Used To Support An Argument That Is Irrelevant

Appellant submits that Board erred by accepting the Examiner’s mischaracterization of an alleged issue that is irrelevant under the law of § 112(2) and accepting the Examiner’s proposed definition of a claim term that runs afoul of the broadest-construction rule as explained *In re Suitco Surface, Inc.*, 603 F.3d 1255 (Fed. Cir. 2010). The claim term at issue has been commonly used throughout the relevant computer-related industries and extensively by the U.S.P.TO. This term at issue is “compatible.” As explained below, the Examiner (and ensuing Board decision) improperly attempts to argue that computer-based “compatibility” is not clear because a computer might want to apply its (programmed) test in a manner that would be subjective (e.g., “[colors] getting along together”), particularly given the arbitrary and entirely unrelated definition adopted by the Examiner’s proposed definition: (colors living together harmoniously or getting along together). It appears that the rejection entirely misinterprets whether a person, rather than the claimed computer, might be executing the test for compatibility.

For a computer to execute a comparison test to determine compatibility (e.g., claim 25), it must determine whether two items (as represented by two data sets) are either compatible or not compatible. Thus, the computer resolves the issue via a yes-no test, regardless of which test is used. This determination of compatibility could be identified independent of the particular compatibility test that is used— so long as some standard/threshold/testing is used. As an example, a computer (or other logic-based electronic device) might employ any of several relevant compatibility tests and the issue here is not which one of compatibility tests was used, but rather the issue is whether one of them was used to resolve the issue with a yes or no resolution. Because claims 25 and 26 clearly set forth that a determination is made to this end – with a simple yes-no resolution -- there is no ambiguity.

This clear-cut approach to defining the scope of an invention has been widely used throughout the relevant computer-related industries for properly setting forth subject matter under 35 U.S.C. § 112 generally and specifically under 35 U.S.C. § 112(2). Indeed, a brief word-based search of the USPTO database reveals that the USPTO has issued over 28,000 patents with the word “compatible” in the claim. A brief sampling of these patents indicates that they are using the term “compatible” in contexts that, using the Examiner’s arbitrary definition, would also be considered invalid for being subjective – even though most (if not the vast majority) of these patent claims are directed to inherently objective-based contexts such as in Appellants case involving objective determination by a non-human apparatus (e.g., computer-based technology, compatible metals, compatible shapes, biologically *compatible* metal device) in which the apparatus has an element (e.g., computer or related logic circuit) that determines whether two items (e.g., as represented by two data sets) are compatible. See, e.g., 7,913,240 (claim 1: “native interface function call is *compatible* with a type of argument in the shape”), and 7,913,288 (claim 1: “published for compatibility with standard computer platforms”); see also over 320 patents of the 28,000 patents issued to Microsoft and IBM with the word “compatible” in the claim. If such a rejection would be properly maintained under § 112(2) based on an arbitrary and unrelated definition of “compatible” (e.g., “getting along together” as asserted by the Examiner), the rationale behind the outstanding § 112(2) rejection would suggest the existence of new law, previously unrecognized by the applicable courts and/or the U.S.P.T.O.

Thus, the skilled artisan would know whether or not some version of a compatibility test was employed, completely independent of which particular version was employed. Moreover, whether or not the parameters of the compatibility test could be considered subjective is not germane to whether or not a skilled artisan could understand that a compatibility test (subjective or otherwise) was used. Thus, as Appellant previously indicated, a computer implementation of a compatibility test could never be truly subjective as operations performed by a computer are, by definition, objective.

Moreover, the BPAI’s attempt to allege that compatibility between colors could be interpreted as being “capable of living together harmoniously or getting along well together with” is not reasonable. As colors do not live or have feelings, they cannot be reasonably

interpreted as living together or getting along well together. Nothing in Appellant's specification hints at compatibility between colors referring to their ability to live or get along together. Thus, the hypothetical interpretation proposed by the BPAI is both illogical and inconsistent with the context of Applicant's specification.

Moreover, the BPAI's reliance upon the cited portion of Appellant's specification appears to rely on an argument that is somewhat circular in its reasoning. The BPAI advances the proposition that the cited language has the effect of extending the scope of the claims by extending "the scope of the word 'compatible' to encompass all measures of compatibility" (BPAI Decision, p. 7). The cited language, however, states that the intention is to cover (additional) aspects that "fall within the spirit and scope of the invention as defined by the claims." Accordingly, the cited portion of Appellant's specification cannot be used to support an interpretation that is neither defined by the claims nor within the spirit and scope of the invention.

Appellant further submits that the authoritative law indicates that it is unreasonable to affirm the rejection based on, as indicated in the Board's Decision, the possibility that "compatible colors" could be interpreted to mean that the colors live together, or colors could get along together. As explained by the Court of Appeals for the Federal Circuit in *In re Suitco Surface, Inc.*, 603 F.3d 1255 (Fed. Cir. 2010), even using the broadest permissible construction must be reasonable in view of the specification and teachings in the underlying specification. Thus, the court explained, "[t]he broadest-construction rubric coupled with the term 'comprising' does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent." *In re Suitco Surface, Inc.*, 603 F.3d at 1260. For the rejected claims 25-26, in light of the specification and teachings, there is no possibility whatsoever that "compatible colors" could be interpreted to mean that the colors live together, or colors could get along together, as asserted because such a context would disregard other aspects set forth by the claim that would require the claimed computer to determine simply whether there is compatibility. Accordingly, the proposed interpretation of the particular claim limitations is illogical, and the rejection and its underlying reasoning cannot stand muster under the law.

Accordingly, the BPAI's finding of facts does not support affirming the Examiner's rejection. Moreover, the skilled artisan would readily know whether or not a computer used a color compatibility test irrespective of the specific test that was used.

For at least the aforementioned reasons, Appellant requests that the BPAI reconsider the affirmation of the Examiner's rejection under §112(2) and reverse the rejection.

The BPAI Should Expressly Recognize That, For Claims 17-31, The Alleged Reason For The Proposed Modification Is Legally Insufficient.

As Appellant argued in the underlying Appeal Brief, without any evidence or articulated reasoning to support that any portion of either reference would provide a suggestion for implementing color matching using a web-linking engine, the rejection cannot be maintained. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (U.S. 2007) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). The Examiner has not provided any reason for combining the references, and has instead relied upon conclusory statements that it would have been obvious to provide color matching because color matching would supply "the purchaser with more complete product information" (Examiner's Answer, p. 4). Moreover, the BPAI's explanation improperly focuses upon the predictability of the proposed combination rather than the reason behind the combination. It is critical that any proper rejection be supported by a clearly articulated and logical reasoning, and not rely upon conclusions of an Examiner.¹

The primary Arnold reference already provides a purchaser with color information and further displays the items to the purchaser. Neither reference suggests that an individual,

¹ "With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine." *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002)

already armed with the color information of two items and/or able to view the two items side-by-side, would gain any benefit from some type of undefined further “color matching.”

For instance, the Dial reference teaches that color matching is useful to assist an individual that is physically located at a retail store, and wishes to match colors with other items of clothing that are located elsewhere. Thus, the entire purpose of the color matching of the Dial reference centers around the realization that individuals may have difficulty assessing colors at a retail store. The relied-upon embodiment of the primary Arnold reference, however, does not exhibit this problem since individuals are provided with a textual description of the color as well as items being displayed side-by-side on a monitor. Thus, the Examiner’s conclusion that there would be “more complete product information” is not supported as the Arnold reference already provides ostensibly complete product information with regards to the color, both in the form of a textual description and by displaying the items to the individuals.

The BPAI also provides no reason for the combination, but instead concludes that “it was predictable to one of ordinary skill to add some form of color matching test to Arnold’s display” (BPAI Decision, p. 8). This is not a reason, but rather is a conclusion of “predictability.” It is irrelevant whether a proposed modification could have been predictably implemented if there is not first a showing of a reason that the proposed modification would have been obvious. *See KSR*, 550 U.S. at 418. Accordingly, the record still lacks any clearly articulated reason to make the proposed combination.

For background reference, Appellant directs the BPAI to teachings of Appellant’s specification that recognize a problem that the cited references do not consider or acknowledge. Appellant’s specification explains that:

A particular problem that arises in connection with shopping electronically concerns color matching. Unlike true shopping where the buying experience involves the ability of the user to color-match articles based on actual appearances, the colors of the articles are mischaracterized when displayed for the shopper over a computer terminal. This alteration is largely due to miscalibrations at both the input (*e.g.*, image capturing) and the output, for example, the display terminal itself. Consequently, few consumers are comfortable color matching items over the internet.

- Appellant’s specification, p. 2

Accordingly, Appellant requests acknowledgement that the BPAI has not presented a legally-valid and clearly articulated reason for the combination because, in part, a conclusion that the combination is predictable is not a clearly articulated reason for why the proposed combination would have been considered obvious. Appellant requests reconsideration of the affirmation of the Examiner's rejections and reversal of the rejections.

The BPAI Introduced A New Grounds Of Rejection.

Appellant respectfully requests acknowledgment that that new grounds of rejection have been introduced in the Instant Appeal Decision. As explained herein, the BPAI improperly indicated that the Examiner's rejection was affirmed and further failed to properly indicate that new grounds for rejection were presented. Appellant submits that the issues raised hereafter are a direct consequence of the BPAI's Decision and its presentation of new grounds of rejection. Thus, Appellant could not have raised these issues earlier. Had the BPAI correctly identified the new grounds of rejection, Appellant would have been afforded the opportunities provided under the relevant legal standards and rules.

The overarching issue in the instant Appeal was whether the Examiner has presented a legally-sufficient basis and, if so, whether Appellant has shown reversible error in the Examiner's findings, *e.g.*, regarding the alleged teachings of the references and the articulated reasoning for the legal conclusion of obviousness. The BPAI has introduced a new grounds for rejection by, for example, stating that “(w)hether the specific input mechanism of Dial is compatible with Arnold is not pertinent to this finding, as Arnold already provides its own input” (BPAI Decision, p. 9). This assertion is problematic because neither the Examiner's grounds for rejection nor the BPAI identifies where this newly-cited “input” resides or any other pertinent information. Although the BPAI may have opined that there would likely be an input somewhere in the proposed combination, no such input was ever identified in the Examiner's proposed combination. This particular combination was therefore never clearly articulated and presented to Appellant. Moreover, this newly-presented combination raises a number of additional factual and legal issues not fully-briefed or otherwise addressed in the record.

For instance, Appellant is uncertain as to what input the BPAI is referring and how the input obtains the color information, where the information resides and how/where the test for compatibility is allegedly executed. Depending upon the specifics of this input, it would be imperative to understand the source of the input, the quality of the input, the accessibility of the input to other portions of the system, as well as to where the data from this input is provided. The newly-alleged and unclear input presents further issues that have not yet been considered. For instance, it is unclear where exactly the alleged compatibility test is implemented and how it relates to the unidentified input. For example, the Examiner's Answer implies that the proposed modification might involve actions carried out by a person, rather than a computer, which of course does not correspond to the claim limitations.² Moreover, there is no explanation as to how or where data from the unidentified input is routed and processed. It is therefore unclear whether the proposed system would include modifications to the virtual outlet, individual merchant websites, a user's computer, all of these elements and/or to something else. Each of these potential modifications raises different concerns and requires different findings of fact. Other considerations not addressed or explained relate to how the data is obtained, which might render the alleged compatibility determination unreliable, unpredictable or otherwise unusable. For instance, the Dial reference would appear to support that the particular manner in which the input device determines the color is critical to any comparison.

Factual determinations regarding these and other details of the proposed modification are not in the record. The BPAI has presented an argument that raises new concerns beyond the Examiner's grounds for rejection and thereby has presented new grounds of rejection.

The record shows that Appellant contested the sufficiency of the factual findings made by the Examiner. The BPAI confirmed that Appellant's points of contention were proper when it presented additional articulation of a new combination not previously found within the Examiner's rejection.

² "Therefore a user would be able to compare the black and white pants to the green shirt (Figure 1B)" (Examiner's Answer, p. 11)

The BPAI effectively admitted the insufficiency of the Examiner's rejection by opining as to a combination that had never been clearly articulated. In doing so, the BPAI then raised issues regarding new theories, legal conclusions and findings of fact. Accordingly, the BPAI's decision has denied Appellant the opportunity to produce evidence and argument, which might rebut the BPAI's materially-different grounds of rejection.

The affirmation of an Examiner upon a previously "nonexistent rejection violates the statutory mandate that the BPAI review 'adverse *decisions of examiners* upon applications for patents,' 35 U.S.C. § 6(b) (2000) (emphasis added), as well as the strictures of 37 C.F.R. § 1.196(a), which specifies that with respect to the grounds of rejection before it, the BPAI, in deciding the appeal, must either 'affirm or reverse the decision of the examiner . . . on the grounds and on the claims specified by the examiner, or remand the application to the examiner for further consideration' (emphasis added)." *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002).

New grounds of rejection should be acknowledged when changes are made to the *precise reason* for the rejection and not upon the statutory basis alone. *See, e.g.*, *Hyatt v. Dudas*, 551 F.3d 1307, 1312 (Fed. Cir. 2008) ("a 'ground of rejection' for purposes of Rule 1.192(c)(7) is not merely the statutory requirement for patentability that a claim fails to meet but also the precise reason why the claim fails that requirement.") Accordingly, it is not proper to materially-change the precise reason for the rejection without acknowledging that such a change represents a new ground of rejection.

Moreover, the PTO places prohibitions on the entrance of new evidence by a patent applicant at this late stage of prosecution³. These prohibitions encourage an Applicant to present evidence at an early stage of prosecution and thereby help ensure that the issues are clearly laid out before an Appeal to the BPAI is made. As a *quid pro quo*, the PTO rules state new grounds for rejection should be identified as such⁴. The identification of such new

³ *See, e.g.*, M.P.E.P. § 1206 ("An amendment, affidavit or other evidence received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded or returned by the Board for such purpose")

⁴ *See, e.g.*, 37 C.F.R. § 41.50 ("Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim.")

grounds is of vital import as new grounds are not considered final for judicial review and also affords a patent applicant with several procedural options for addressing the new grounds⁵.

The logic behind such requirements should be clear. For instance, had the Examiner correctly provided sufficient explanation as to the grounds of rejection, as implicitly acknowledged by the BPAI's Decision, Appellant would have then had ample opportunity to respond with argument and evidence or, if necessary, to make amendments to the claims. Appellant should not be denied this opportunity simply because the Examiner failed to recognize these deficiencies, thereby forcing the BPAI to temporarily take the place of the Examiner. Here, the BPAI has confirmed the Examiner's failure to present a clearly-articulated rejection, yet the BPAI has improperly affirmed the Examiner. Regardless of the validity of any newly-crafted grounds for rejection, the record indicates that the Examiner's rejections were legally insufficient to provide an adequate showing of obviousness.

Appellant recognizes that the PTO rules grant the BPAI the power to put forth new grounds for rejection. In doing so, the BPAI effectively takes the place of the Examiner by presenting new arguments, evidence and/or findings of fact; however, the PTO rules also provide several avenues of recourse for an Appellant should the BPAI choose to exercise this power. If patent applicants were to be denied such avenues of recourse, the ramifications would be severe. For instance, any error in the BPAI's newly presented argument could not be rebutted by argument or evidence⁶. Since it would be unreasonable to expect an Applicant to predict any and all conceivable positions that the PTO might take with regards to a particular set of facts, irrespective of their validity, any denial of such recourse is not merely harmless error.

In this instance, the BPAI presented new factual conclusions that require new findings of fact and raise a number of additional issues not yet fully-developed in the record. Thus, even though the BPAI rejected the claims using the same statutory basis, the BPAI changed the *precise reason* for why the claims were asserted as failing a statutory

⁵ See, e.g., 37 C.F.R. § 41.50 ("A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.")

⁶ See, e.g., 37 C.F.R. § 41.52(a)(1) "Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section."

requirement. The PTO rules, as interpreted by the Federal Circuit, require that such changes be considered new grounds. *Hyatt v. Dudas*, at 1312 (Fed. Cir. 2008). In view of this material change in the precise reason for rejecting the claims, the BPAI should not have affirmed the Examiner and should have recognized that new grounds for the rejection were presented.

The BPAI's improper affirmation has the effect of precluding Appellant from presenting new arguments and evidence that would rebut the new findings, arguments and legal conclusions. Without having been afforded the required avenues of recourse, such as those provided by 37 C.F.R. § 41.50(b), Appellant has been improperly denied the opportunities required by an Administrative Procedure Act⁷. As examples of possible harm, Appellant submits the very real possibility that the BPAI may have overlooked a material aspect of the record, failed to consider one or more factors relevant to patentability or simply was unaware of additional evidence that has not been submitted, such evidence might shed additional light on the BPAI's new findings.

For at least the aforementioned, the BPAI should acknowledge the new grounds for rejection and afford Appellant the avenues of recourse required by the PTO rules, at which time Appellant would consider claim amendments that might render the current issues moot.

In view of the above, Appellant respectfully requests that the BPAI acknowledge that the rejections presented by the BPAI in its Appeal Decision constitute new grounds of rejection.

⁷ See, e.g., *In re Kumar*, 418 F.3d 1361, 1367 (Fed. Cir. 2005) ("In accordance with the Administrative Procedure Act, the agency must assure that an applicant's petition is fully and fairly treated at the administrative level, without interim need for judicial intervention. See *Dickinson v. Zurko*, 527 U.S. 150, 154, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (the PTO is an agency subject to the Administrative Procedure Act). The Board's rules are in accord. See 37 C.F.R. § 1.196(b) (when the Board relies on a new ground of rejection, it is appropriate to provide the applicant with an opportunity to respond to that ground)."

There Is Not A *Prima Facie* Case For Rejection Of Each Of Claims 18-31 Because The BPAI Did Not Address Limitations Of These Claims With Regards To The New Grounds Of Rejection.

The record does not contain a *prima facie* case for the rejection of claims 18-31. The BPAI introduced material changes relative to the factual findings of the Examiner, the alleged combination of references and the reason for the legal conclusion of obviousness. In doing so, the BPAI introduced a new basis for the rejection of claim 17; however, the BPAI failed to address the limitations of any of the remaining claims in view of the newly-presented grounds of rejection. Thus, there is not a *prima facie* case for the rejections.

To the extent that Appellant grouped claims for the instant Appeal, the grouping of claims was made with respect to the issues upon which the Appeal was originally based. Once the BPAI modified the grounds of rejection, the grouping of claims made by Appellant ceased to be applicable. To hold otherwise would deprive Appellant of being first appraised of the basis for the rejection and then being afforded an opportunity to respond thereto⁸.

Accordingly, the rejection of claims 18-31 should be reversed.

⁸ See, e.g., *In re Kumar*, 418 F.3d 1361, 1367 (Fed. Cir. 2005) (“these values produced and relied on by the Board had not previously been identified by the examiner or the Board. Kumar was entitled to respond to these calculations, and the Board committed procedural error in refusing to consider the evidence proffered in response.”)

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In view of the above, Appellant submits that the BPAI's decision reverses the Examiner's rejections of claims 17-31, and constitutes new grounds of rejection. Appellant therefore requests that these rejections be identified as new grounds of rejection by the BPAI so that Appellant is afforded a fair opportunity to respond thereto (*e.g.*, as provided under 37 C.F.R. § 41.50(b)).

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